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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------|-------------|-----------------------|---------------------|------------------|
| 10/613,829 | 07/03/2003 | Szabo Miszenti Sergio | 1011-558 | 6801 |
| 47888 | 7590 | 04/19/2005 | EXAMINER | |
| HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036 | | | COOLEY, CHARLES E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1723 | |

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,829

Applicant(s)

SERGIO, SZABO MISZENTI

Examiner

Charles E. Cooley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

NON-FINAL OFFICE ACTION

1. This application has been assigned to Technology Center 1700, Art Unit 1723 and the following will apply for this application:

Please direct all written correspondence with the correct application serial number for this application to Art Unit 1723.

Telephone inquiries regarding this application should be directed to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197 or to the Examiner at (571) 272-1139. All official facsimiles should be transmitted to (703) 872-9306.

2. As the PTO continues to move towards a fully electronic environment, the office will phase-in its E-Patent Reference program. This program: (1) provides downloading capability of the U.S. patents and U.S. patent application publications cited in Office actions via the E-Patent Reference feature of the Office's PAIR system; and (2) ceases mailing paper copies of U.S. patents and U.S. patent application publications with office actions except for citations made during the international stage of an international application under PCT.

Effective June 2004, paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions from this Technology Center. Paper copies of foreign patents and non-patent literature will continue to be included with office actions.

The U.S. patents and patent application publications cited in office actions are available for download via the Office's PAIR system. As an alternate source, all U.S.

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patents and patent application publications are available on the USPTO web site

(www.uspto.gov), from the Office of Public Records and from commercial sources.

Inquiries about the use of the Office's PAIR system should be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Requests to restart a period for response due to a missing U.S. patent or patent application publications will not be granted.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119, which papers have been placed of record in the file.

Drawings

4. The drawings are objected to because of the following informalities:
 - a. the second guide 12 should be shown in Fig. 1.
 - b. the belt 8 should be labeled in Fig. 2.
 - c. the Figure legends are poor (37 CFR 1.84(p)).
 - d. the framework of the device should be given a reference numeral (also note section 7(a) below).

Correction is required.

5. Applicant should verify that (1) all reference characters in the drawings are described in the detailed description portion of the specification and (2) all reference

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characters mentioned in the specification are included in the appropriate drawing

Figure(s) as required by 37 CFR 1.84(p)(5).

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Specification

6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The disclosure is objected to because of the following informalities:

a. Page 4, line 8: replace "11" with --11, 12-- and delete "12" after framework.

Appropriate correction is required.

8. The use of the trademarks SURLYN and TEFLON have been noted in this application. They should be capitalized wherever it appears and be accompanied by the generic terminology. The specification and claim 24 require correction.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The abstract is acceptable.

10. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed (MPEP 606.01).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 2, 4, 5, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US 5,467,706).

The patent to Kato '706 discloses a machine comprising two supporting shoulders 7, 22; each said supporting shoulder being rigidly coupled to a cam follower 11 and/or 12 affected by a cam 32 in turn driven by a motor 29, to cause said supporting shoulders to perform a rectilinear symmetrically opposite reciprocating movement; said supporting shoulders 7, 22 are coupled to a pair of parallel guides 2, 6, 21 rigid with the framework 1, 2 of said machine; said motor 29 comprises a motor shaft on which is mounted a pulley 30, thereon is entrained a transmission belt 31 rotatively driving a second pulley 28 keyed on a second shaft 25 supporting said cam 32; said cam 32 is a desmodromic cam with inner and outer contours and thereon respectively slide inner follower rollers 11 and outer follower rollers 12; wherein an inner follower roller 11 is pivoted, together with a respective outer follower roller 12, to an arm 14 rigid with a said supporting shoulder 7, whereas the other inner follower roller 11 is pivoted, together with a respective outer follower roller 12, to a second arm 18 rigid with the second supporting shoulder.

The "adapted " clause of claim 1 is of no patentable consequence because it has been held that the recitation that an element is "adapted" to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

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13. Claims 1, 2, 4, 8, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US 5, 687,645).

The patent to Kato '645 discloses a machine comprising two supporting shoulders 7, 9; each said supporting shoulder being rigidly coupled to a cam follower 19, 20 affected by a cam 16 in turn driven by a motor (col. 3, lines 29-30), to cause said supporting shoulders to perform a rectilinear symmetrically opposite reciprocating movement; said supporting shoulders 7, 9 are coupled to a pair of parallel guides 6, 8 rigid with the framework 1 of said machine; said motor comprises a motor shaft on which is mounted a pulley driving a transmission belt 15 rotatively driving a second pulley 14 keyed on a second shaft 10 supporting said cam 16; said cam 16 is a non-desmodromic cam having a single outer contour, thereon slide two cam followers 19, 20 associated with respective arms 17, 18 connected to said supporting shoulders 7, 9, said supporting shoulders 7, 9 being in turn connected by a pair of return springs 21, 22, allowing the cam followers to follow the cam contour.

The "adapted" clause of claim 1 is of no patentable consequence because it has been held that the recitation that an element is "adapted" to perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 5,467,706) or Kato (US 5, 687,645) in view of Kahl (US 4,747,693).

Kato (US 5,467,706) or Kato (US 5, 687,645) do not disclose the motor being an electronically controlled variable speed electric motor. Kahl discloses a device for agitating test tubes including a shoulder 20 for supporting test tubes 50 which is driven by a motor 10. The motor 10 is an electronically controlled variable speed electric motor. It would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified the motors of Kato '706 or '645 such that the motors thereof are electronically controlled variable speed electric motors for the purpose of controlling the motor speed to thereby adjust the frequency of agitation of the device (col. 3, lines 37-41).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited prior art discloses cam driven agitating devices.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Cooley whose telephone number is (571)

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272-1139. The examiner can normally be reached on Mon-Fri. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Charles", followed by a long, horizontal, wavy line that extends to the right.

Charles E. Cooley
Primary Examiner
Art Unit 1723

15 April 2005